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SUBJECT Appeal Brief (10/002,438)

Number of Pages 42

Date 7/21/2005

MESSAGE

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1. one copy of a Fax Transmittal Form;
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3. three copies of an Appeal Brief.

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**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

TRANSMITTAL FORM <small>(to be used for all correspondence after initial filing)</small>	Application Number	10/002,438
	Filing Date	11/01/2001
	First Named Inventor	Awada et al.
	Art Unit	2176
	Examiner Name	Laurie Anne Ries
Total Number of Pages in This Submission	Attorney Docket Number	
	AU3920010885US1	

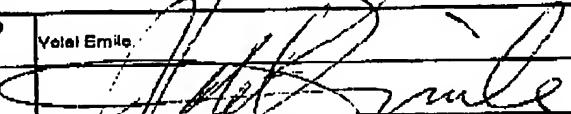
ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <div style="border: 1px solid black; padding: 2px; margin-top: 5px;">Remarks</div> <p>Appeal Brief.</p>	<input type="checkbox"/> After Allowance communication to Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below): <p>Appeal Brief.</p>

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Volel Emile
Signature	
Date	07/21/2005

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Typed or printed name	Volel Emile
Signature	
Date	07/21/2005

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JUL 21 2005

Appl. No. 10/002,438
Appeal Brief dated 07/21/2005
Reply to Office Action of 03/21/2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Application of: :
Awada et al. :
Serial No: 10/002,438 : Before the Examiner:
: Laurie Anne Ries
Filed: 11/01/2001 : Group Art Unit: 2176
Title: APPARATUS AND METHOD : Confirmation No.: 3560
OF BOOKMARKING A SECTION OF A :
WEB PAGE :
:

TRANSMITTAL OF APPELLANTS' BRIEF UNDER 37 C.F.R. 1.192(a)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attached is Appellant's Brief, in triplicate, from a decision of the Examiner dated 03/21/2005, finally rejecting the claims in the Application.

The item(s) marked below are appropriate:

1. A petition and fee for extension of term for reply to the final rejection is attached.
2. Appeal fee
 other than a small entity. Fee: \$500.00
3. Payment
 Please charge Deposit Account 09-0447 the sum of \$500.00. A duplicate of this notice is attached.

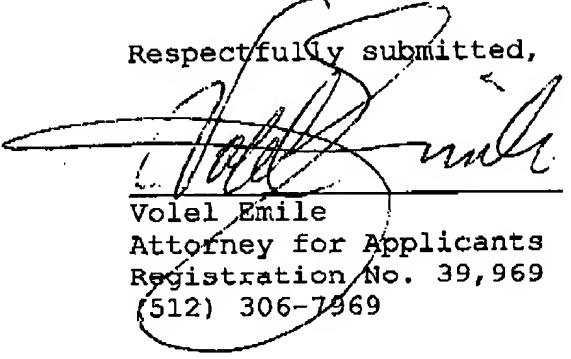
AUS920010885US1

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Appl. No. 10/002,438
Appeal Brief dated 07/21/2005
Reply to Office Action of 03/21/2005

The Commissioner is hereby authorized to charge any additional fee, which may be required or credit any overpayment to Deposit Account No. 09-0447.

Respectfully submitted,


Volel Emile
Attorney for Applicants
Registration No. 39,969
(512) 306-7969

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Appeal Brief dated 07/21/2005
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JUL 21 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Application of:	:
Awada et al.	:
Serial No: 10/002,438	: Before the Examiner:
Filed: 11/01/2001	: Laurie Anne Ries
Title: APPARATUS AND METHOD OF BOOKMARKING A SECTION OF A WEB PAGE	: Group Art Unit: 2176
	: Confirmation No.: 3560
	:
	:

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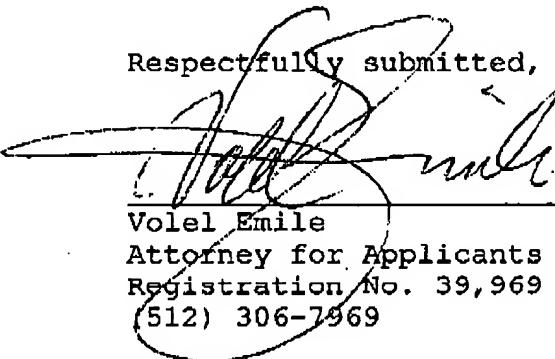
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OF BOOKMARKING A SECTION OF A :
WEB PAGE :
:

APPELLANTS' BRIEF UNDER 37 C.F.R. 1.192

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is an appeal to a final rejection dated March 21, 2005 of claims 1, 6, 7, 12, 13, 18, 19 and 24 of Application Serial Number 10/002,438 filed on November 01, 2001. This Appeal Brief is submitted pursuant to a Notice of Appeal filed on June 17, 2005 in accordance with 37 C.F.R. 1.192.

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Reply to Office Action of 03/21/2005

BRIEF FOR APPLICANTS - APPELLANTS

(1)

Real Party in Interest

The real party in interest is International Business Machines Corporation (IBM), the assignee.

(2)

Related Appeals and Interferences

There are no other appeals or interferences known to appellants, appellants' representative or assignee, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3)

Status of Claims

Claims 1, 6, 7, 12, 13, 18, 19 and 24 have been finally rejected. This appeal involves all the rejected claims.

(4)

Status of Amendment

A Response to the first Office Action, in which Claims 1, 6, 7, 12, 13, 18, 19 and 24 were amended and Claims 2 - 5, 8 - 11, 14 - 17 and 20 - 23 were canceled was filed on November 24, 2004.

In that Office Action, the Examiner conceded that Brisebois et al. do not teach storing font attributes when bookmarking a page such that the page may be re-accessed at the section that was displayed when the page was AUS920010885US1

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bookmarked. Nonetheless, the Examiner rejected Claim 5. In support of the rejection, the Examiner stated that Littlefield et al. teach storing font attributes. And, since the teachings of Littlefield et al. and those of Brisebois et al. are analogous, the Examiner reasoned, it would have been obvious for one skilled in the art to combine the teachings of Brisebois et al. with those of Littlefield et al. to arrive at the claimed invention. Applicants respectfully disagree.

In the Response to the First Office Action, Applicants amended independent Claim 1 to include the limitations of Claim 5 (the other independent claims were likewise amended to include the limitations of claims that are generally of the same scope as Claim 5) and argued the remaining claims patentability.

The Examiner did not find Applicants' arguments to be persuasive and issued a final rejection of the remaining claims in the Application on March 21, 2005.

(5)

Summary of the Invention

When a user accesses a Web page that may later be re-visited, the user may bookmark the page. But, when the Web page is re-visited, the page is always displayed at its beginning. If the user wants to return to a passage that is in the middle or near the end of the page, the user has to scroll down the page looking for the passage. This is a rather aggravating aspect of accessing bookmarked pages (see page 2, lines 4 - 11).

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The present invention allows a user to access a bookmarked Web page and to have the section that was on the screen when the page was bookmarked to be again on the screen when the bookmarked page is accessed see page 10, lines 25 - 32).

This can be quite a convenient feature. Specifically, users usually bookmark a Web page after reading a passage from the page that the user has found to be interesting. The passage is ordinarily displayed on the screen when the page is bookmarked. Generally, when a user re-accesses a bookmarked Web page, the user ordinarily wants to find the passage that prompted the user to bookmark the page.

Thus, according to the invention, when a user bookmarks a page, the network address of the page is stored (see page 12, lines 21 - 25). Along with the network address is stored the section of the page that was displayed when the user bookmarks the page. To store the section of the page that was displayed, the invention stores the size of the window in which the page was displayed, the position of the scroll boxes in the vertical and horizontal scroll bars and the font attributes (e.g., font name, style and size etc.) that were used to display the page (see page 25, lines 25 - 30).

The font attributes are used to ensure that the proper section of the page is displayed since the same character and/or character size will be used each time the bookmarked page is accessed (see page 13, lines 10 - 14 and independent Claims 1, 3, 5 and 7 in the Appendix).

(6)

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Reply to Office Action of 03/21/2005

Issues

Whether claims 1, 6, 7, 12, 13, 18, 19 and 24 were properly rejected under §103(a) as being unpatentable over Brisebois in view of Littlefield et al.

(7)

Grouping of Claims

The rejected claims stand or fall together.

(8)

Argument

In considering a Section §103 rejection, the subject matter of the claim "as a whole" must be considered and analyzed. In the analysis, it is necessary that the scope and contents of the prior art and differences between the art and the claimed invention (taken as a whole) be determined. *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

As mentioned before, the Examiner conceded that Brisebois et al. do not teach storing font attributes when bookmarking a page such that the page may be re-accessed at the section that was displayed when the page was bookmarked. But, the Examiner relied on Littlefield et al. to show this missing element. Applicants submit that Littlefield et al. also fail to show the missing element.

Littlefield et al. purport to teach techniques for delivering search results pages to users of a search engine where one or more search result listings on the search results pages include items that are not included by default. The non-default items may take many forms, including but not limited to images, banners, controls,
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Appl No. 10/002,438
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animations, and even Java applets. The non-default items may be designed to entice the search engine users to select the search result listing with which they are associated over possibly higher-ranked search result listings that contain only default items.

The non-default items may also be text with one or more non-default font attributes. When text with one or more non-default font attributes is used as a non-default item, the font attributes information is entered or placed at locations within a search result web page to cause all or a portion of the appropriate search result listing to properly display the non-default item (i.e., in the font attribute).

In the passage cited by the Examiner in support for the rejection, Littlefield et al. use the phrase "storing the font attribute at locations within a search result web page" Since the results of the Web search are not stored but merely presented or displayed to a user, then the font attribute information is not stored but merely "entered or placed at the proper locations within the search result web page ..."

Further, it should be noted that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992)

In addition, "[o]bviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion

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supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 221 USPQ 929, 932, 933 (Fed. Cir. 1984)

The primary reference used by the Examiner (i.e., Brisebois et al.) purportedly teach a method of bookmarking a Web page that includes information to display the bookmarked page whenever it is accessed anytime thereafter at the section that was displayed on the screen when the page was originally bookmarked. According to the teachings of Brisebois et al., the entire content of the Web page is assigned X,Y coordinates that are relative to the upper-leftmost corner (i.e., $X,Y=0,0$) and to the bottom-rightmost corner ($X,Y=x_{max},y_{max}$) of the page. The section of the text that was displayed when the page is bookmarked is stored or recorded using its relative X,Y coordinates. Further, the size of the window in which the page was displayed when it was bookmarked is also recorded. Using the recorded size of the window as well as the X,Y coordinates of the section of the text that was displayed, the Web page can always be displayed at the section that was displayed whenever the bookmarked Web page is accessed.

Since Brisebois et al. specifically teach a method of bookmarking Web pages such that the Web pages may be accessed at the section that was displayed on the screen when the page was originally bookmarked without the use of font attributes, Applicants fail to see why anyone would combine the teachings of Littlefield et al. with those of Brisebois et al. Especially when the teachings in Littlefield et al. are directed to techniques for AUS920010885US1

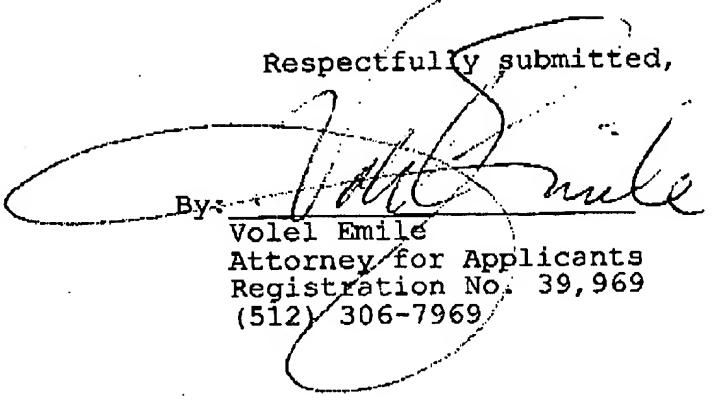
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delivering search results while the teachings of Brisebois et al. are directed to a method of bookmarking a Web page.

Applicants submit that the rejected claims are allowable over the cited references. Hence, Applicants request reversal of the rejection, allowance and passage to issue of the claims in the application.

Respectfully submitted,

By:


Volel Emile
Attorney for Applicants
Registration No. 39,969
(512) 306-7969

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Appendix

1. (Previously presented) A method of bookmarking a section of a Web page comprising the steps of:

storing a network address of the page; and

storing the section of the page such that when the network address is used to access and display the page, the section of the page is displayed, the section storing step including the steps of storing a current size of a window within which the page is displayed, storing positions of scroll boxes in scroll bars in the window and storing font attributes of the displayed page.
2. Canceled.
3. Canceled.
4. Canceled.
5. Canceled.
6. (Previously presented) The method of Claim 1 wherein the step of storing the section of the page includes storing X-Y coordinates of the window and the scroll boxes.

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7. (Previously presented) A computer program product on a computer readable medium for bookmarking a section of a Web page comprising:

code means for storing a network address of the page; and

code means for storing the section of the page such that when the network address is used to access and display the page, the section of the page is displayed, the section storing code means including code means for storing a current size of a window within which the page is displayed, code means for storing positions of scroll boxes in scroll bars in the window and code means for storing font attributes of the displayed page.

8. Canceled.

9. Canceled.

10. Canceled.

11. Canceled.

12. (Previously presented) The computer program product of Claim 7 wherein the code means for storing the section of the page includes code means for storing X-Y coordinates of the window and the scroll boxes.

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13. (Previously presented) An apparatus for bookmarking a section of a Web page comprising:

means for storing a network address of the page; and

means for storing the section of the page such that when the network address is used to access and display the page, the section of the page is displayed, the section storing means including means for storing a current size of a window within which the page is displayed, means for storing positions of scroll boxes in scroll bars in the window and means for storing font attributes of the displayed page.

14. Canceled.

15. Canceled.

16. Canceled.

17. Canceled.

18. (Previously presented) The apparatus of Claim 13 wherein the means for storing the section of the page includes means for storing X-Y coordinates of the window and the scroll boxes.

19. (Previously presented) A computer system for bookmarking a section of a Web page comprising:

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at least a memory device for storing data;

at least a processor for processing said data to store a network address of the page and to store the section of the page such that when the network address is used to access and display the page, the section of the page is displayed, the data is further processed to store a current size of a window within which the page is displayed, to store positions of scroll boxes in scroll bars in the window and to store font attributes of the displayed page.

20. Canceled.
21. Canceled.
22. Canceled.
23. Canceled.
24. (Previously presented) The computer system of Claim 19 wherein the section of the page is stored by further storing X-Y coordinates of the window and the scroll boxes.

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APPELLANTS' BRIEF UNDER 37 C.F.R. 1.192

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BRIEF FOR APPLICANTS - APPELLANTS

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Real Party in Interest

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The Examiner did not find Applicants' arguments to be persuasive and issued a final rejection of the remaining claims in the Application on March 21, 2005.

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Summary of the Invention

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Thus, according to the invention, when a user bookmarks a page, the network address of the page is stored (see page 12, lines 21 - 25). Along with the network address is stored the section of the page that was displayed when the user bookmarks the page. To store the section of the page that was displayed, the invention stores the size of the window in which the page was displayed, the position of the scroll boxes in the vertical and horizontal scroll bars and the font attributes (e.g., font name, style and size etc.) that were used to display the page (see page 25, lines 25 - 30).

The font attributes are used to ensure that the proper section of the page is displayed since the same character and/or character size will be used each time the bookmarked page is accessed (see page 13, lines 10 - 14 and independent Claims 1, 3, 5 and 7 in the Appendix).

(6)

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Issues

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Grouping of Claims

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Argument

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The non-default items may also be text with one or more non-default font attributes. When text with one or more non-default font attributes is used as a non-default item, the font attributes information is entered or placed at locations within a search result web page to cause all or a portion of the appropriate search result listing to properly display the non-default item (i.e., in the font attribute).

In the passage cited by the Examiner in support for the rejection, Littlefield et al. use the phrase "storing the font attribute at locations within a search result web page" Since the results of the Web search are not stored but merely presented or displayed to a user, then the font attribute information is not stored but merely "entered or placed at the proper locations within the search result web page ..."

Further, it should be noted that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992)

In addition, "[o]bviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion AUS920010885US1

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supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 221 USPQ 929, 932, 933 (Fed. Cir. 1984)

The primary reference used by the Examiner (i.e., Brisebois et al.) purportedly teach a method of bookmarking a Web page that includes information to display the bookmarked page whenever it is accessed anytime thereafter at the section that was displayed on the screen when the page was originally bookmarked. According to the teachings of Brisebois et al., the entire content of the Web page is assigned X,Y coordinates that are relative to the upper-leftmost corner (i.e., X,Y=0,0) and to the bottom-rightmost corner (X,Y=x_{max},y_{max}) of the page. The section of the text that was displayed when the page is bookmarked is stored or recorded using its relative X,Y coordinates. Further, the size of the window in which the page was displayed when it was bookmarked is also recorded. Using the recorded size of the window as well as the X,Y coordinates of the section of the text that was displayed, the Web page can always be displayed at the section that was displayed whenever the bookmarked Web page is accessed.

Since Brisebois et al. specifically teach a method of bookmarking Web pages such that the Web pages may be accessed at the section that was displayed on the screen when the page was originally bookmarked without the use of font attributes, Applicants fail to see why anyone would combine the teachings of Littlefield et al. with those of Brisebois et al. Especially when the teachings in Littlefield et al. are directed to techniques for AUS920010885US1

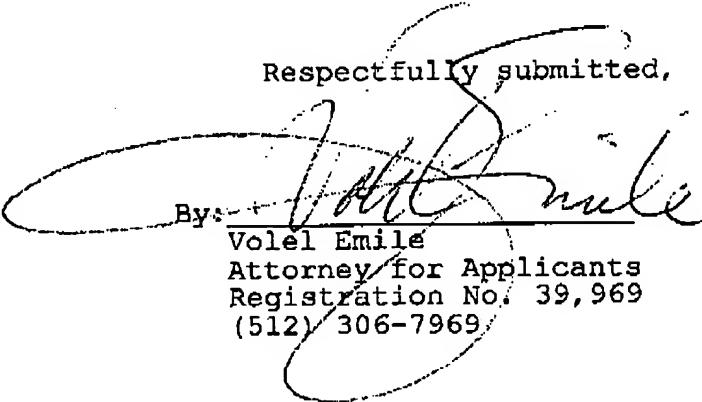
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delivering search results while the teachings of Brisebois et al. are directed to a method of bookmarking a Web page.

Applicants submit that the rejected claims are allowable over the cited references. Hence, Applicants request reversal of the rejection, allowance and passage to issue of the claims in the application.

Respectfully submitted,

By: +


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Appendix

1. (Previously presented) A method of bookmarking a section of a Web page comprising the steps of:

storing a network address of the page; and

storing the section of the page such that when the network address is used to access and display the page, the section of the page is displayed, the section storing step including the steps of storing a current size of a window within which the page is displayed, storing positions of scroll boxes in scroll bars in the window and storing font attributes of the displayed page.
2. Canceled.
3. Canceled.
4. Canceled.
5. Canceled.
6. (Previously presented) The method of Claim 1 wherein the step of storing the section of the page includes storing X-Y coordinates of the window and the scroll boxes.

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7. (Previously presented) A computer program product on a computer readable medium for bookmarking a section of a Web page comprising:

code means for storing a network address of the page;
and

code means for storing the section of the page such that when the network address is used to access and display the page, the section of the page is displayed, the section storing code means including code means for storing a current size of a window within which the page is displayed, code means for storing positions of scroll boxes in scroll bars in the window and code means for storing font attributes of the displayed page.

8. Canceled.

9. Canceled.

10. Canceled.

11. Canceled.

12. (Previously presented) The computer program product of Claim 7 wherein the code means for storing the section of the page includes code means for storing X-Y coordinates of the window and the scroll boxes.

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13. (Previously presented) An apparatus for bookmarking a section of a Web page comprising:

means for storing a network address of the page; and

means for storing the section of the page such that when the network address is used to access and display the page, the section of the page is displayed, the section storing means including means for storing a current size of a window within which the page is displayed, means for storing positions of scroll boxes in scroll bars in the window and means for storing font attributes of the displayed page.

14. Canceled.

15. Canceled.

16. Canceled.

17. Canceled.

18. (Previously presented) The apparatus of Claim 13 wherein the means for storing the section of the page includes means for storing X-Y coordinates of the window and the scroll boxes.

19. (Previously presented) A computer system for bookmarking a section of a Web page comprising:

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at least a memory device for storing data;

at least a processor for processing said data to store a network address of the page and to store the section of the page such that when the network address is used to access and display the page, the section of the page is displayed, the data is further processed to store a current size of a window within which the page is displayed, to store positions of scroll boxes in scroll bars in the window and to store font attributes of the displayed page.

20. Canceled.
21. Canceled.
22. Canceled.
23. Canceled.
24. (Previously presented) The computer system of Claim 19 wherein the section of the page is stored by further storing X-Y coordinates of the window and the scroll boxes.

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JUL 21 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Application of: :
Awada et al. :
Serial No: 10/002,438 : Before the Examiner:
Filed: 11/01/2001 : Laurie Anne Ries
Title: APPARATUS AND METHOD : Group Art Unit: 2176
OF BOOKMARKING A SECTION OF A : Confirmation No.: 3560
WEB PAGE :
:

APPELLANTS' BRIEF UNDER 37 C.F.R. 1.192

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is an appeal to a final rejection dated March 21, 2005 of claims 1, 6, 7, 12, 13, 18, 19 and 24 of Application Serial Number 10/002,438 filed on November 01, 2001. This Appeal Brief is submitted pursuant to a Notice of Appeal filed on June 17, 2005 in accordance with 37 C.F.R. 1.192.

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BRIEF FOR APPLICANTS - APPELLANTS

(1)

Real Party in Interest

The real party in interest is International Business Machines Corporation (IBM), the assignee.

(2)

Related Appeals and Interferences

There are no other appeals or interferences known to appellants, appellants' representative or assignee, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3)

Status of Claims

Claims 1, 6, 7, 12, 13, 18, 19 and 24 have been finally rejected. This appeal involves all the rejected claims.

(4)

Status of Amendment

A Response to the first Office Action, in which Claims 1, 6, 7, 12, 13, 18, 19 and 24 were amended and Claims 2 - 5, 8 - 11, 14 - 17 and 20 - 23 were canceled was filed on November 24, 2004.

In that Office Action, the Examiner conceded that Brisebois et al. do not teach storing font attributes when bookmarking a page such that the page may be re-accessed at the section that was displayed when the page was AUS920010885US1

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bookmarked. Nonetheless, the Examiner rejected Claim 5. In support of the rejection, the Examiner stated that Littlefield et al. teach storing font attributes. And, since the teachings of Littlefield et al. and those of Brisebois et al. are analogous, the Examiner reasoned, it would have been obvious for one skilled in the art to combine the teachings of Brisebois et al. with those of Littlefield et al. to arrive at the claimed invention. Applicants respectfully disagree.

In the Response to the First Office Action, Applicants amended independent Claim 1 to include the limitations of Claim 5 (the other independent claims were likewise amended to include the limitations of claims that are generally of the same scope as Claim 5) and argued the remaining claims patentability.

The Examiner did not find Applicants' arguments to be persuasive and issued a final rejection of the remaining claims in the Application on March 21, 2005.

(5)

Summary of the Invention

When a user accesses a Web page that may later be re-visited, the user may bookmark the page. But, when the Web page is re-visited, the page is always displayed at its beginning. If the user wants to return to a passage that is in the middle or near the end of the page, the user has to scroll down the page looking for the passage. This is a rather aggravating aspect of accessing bookmarked pages (see page 2, lines 4 - 11).

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The present invention allows a user to access a bookmarked Web page and to have the section that was on the screen when the page was bookmarked to be again on the screen when the bookmarked page is accessed see page 10, lines 25 - 32).

This can be quite a convenient feature. Specifically, users usually bookmark a Web page after reading a passage from the page that the user has found to be interesting. The passage is ordinarily displayed on the screen when the page is bookmarked. Generally, when a user re-accesses a bookmarked Web page, the user ordinarily wants to find the passage that prompted the user to bookmark the page.

Thus, according to the invention, when a user bookmarks a page, the network address of the page is stored (see page 12, lines 21 - 25). Along with the network address is stored the section of the page that was displayed when the user bookmarks the page. To store the section of the page that was displayed, the invention stores the size of the window in which the page was displayed, the position of the scroll boxes in the vertical and horizontal scroll bars and the font attributes (e.g., font name, style and size etc.) that were used to display the page (see page 25, lines 25 - 30).

The font attributes are used to ensure that the proper section of the page is displayed since the same character and/or character size will be used each time the bookmarked page is accessed (see page 13, lines 10 - 14 and independent Claims 1, 3, 5 and 7 in the Appendix).

(6)

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Issues

Whether claims 1, 6, 7, 12, 13, 18, 19 and 24 were properly rejected under §103(a) as being unpatentable over Brisebois in view of Littlefield et al.

(7)

Grouping of Claims

The rejected claims stand or fall together.

(8)

Argument

In considering a Section §103 rejection, the subject matter of the claim "as a whole" must be considered and analyzed. In the analysis, it is necessary that the scope and contents of the prior art and differences between the art and the claimed invention (taken as a whole) be determined. *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

As mentioned before, the Examiner conceded that Brisebois et al. do not teach storing font attributes when bookmarking a page such that the page may be re-accessed at the section that was displayed when the page was bookmarked. But, the Examiner relied on Littlefield et al. to show this missing element. Applicants submit that Littlefield et al. also fail to show the missing element.

Littlefield et al. purport to teach techniques for delivering search results pages to users of a search engine where one or more search result listings on the search results pages include items that are not included by default. The non-default items may take many forms, including but not limited to images, banners, controls, AUS920010885US1

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animations, and even Java applets. The non-default items may be designed to entice the search engine users to select the search result listing with which they are associated over possibly higher-ranked search result listings that contain only default items.

The non-default items may also be text with one or more non-default font attributes. When text with one or more non-default font attributes is used as a non-default item, the font attributes information is entered or placed at locations within a search result web page to cause all or a portion of the appropriate search result listing to properly display the non-default item (i.e., in the font attribute).

In the passage cited by the Examiner in support for the rejection, Littlefield et al. use the phrase "storing the font attribute at locations within a search result web page" Since the results of the Web search are not stored but merely presented or displayed to a user, then the font attribute information is not stored but merely "entered or placed at the proper locations within the search result web page ..."

Further, it should be noted that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992)

In addition, "[o]bviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion

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The primary reference used by the Examiner (i.e., Brisebois et al.) purportedly teach a method of bookmarking a Web page that includes information to display the bookmarked page whenever it is accessed anytime thereafter at the section that was displayed on the screen when the page was originally bookmarked. According to the teachings of Brisebois et al., the entire content of the Web page is assigned X,Y coordinates that are relative to the upper-leftmost corner (i.e., $X,Y=0,0$) and to the bottom-rightmost corner ($X,Y=X_{max},Y_{max}$) of the page. The section of the text that was displayed when the page is bookmarked is stored or recorded using its relative X,Y coordinates. Further, the size of the window in which the page was displayed when it was bookmarked is also recorded. Using the recorded size of the window as well as the X,Y coordinates of the section of the text that was displayed, the Web page can always be displayed at the section that was displayed whenever the bookmarked Web page is accessed.

Since Brisebois et al. specifically teach a method of bookmarking Web pages such that the web pages may be accessed at the section that was displayed on the screen when the page was originally bookmarked without the use of font attributes, Applicants fail to see why anyone would combine the teachings of Littlefield et al. with those of Brisebois et al. Especially when the teachings in Littlefield et al. are directed to techniques for

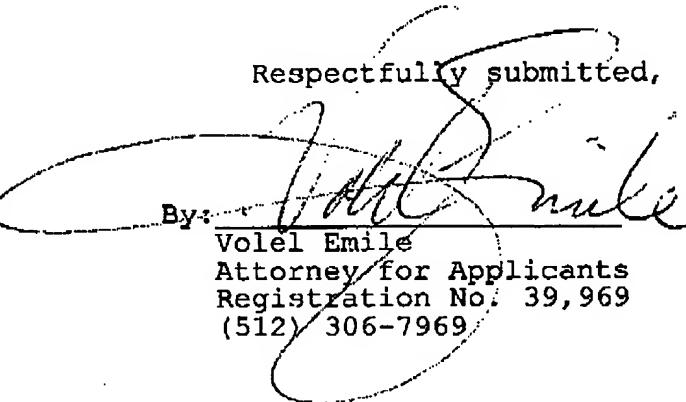
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delivering search results while the teachings of Brisebois et al. are directed to a method of bookmarking a Web page.

Applicants submit that the rejected claims are allowable over the cited references. Hence, Applicants request reversal of the rejection, allowance and passage to issue of the claims in the application.

Respectfully submitted,

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Appendix

1. (Previously presented) A method of bookmarking a section of a Web page comprising the steps of:

storing a network address of the page; and

storing the section of the page such that when the network address is used to access and display the page, the section of the page is displayed, the section storing step including the steps of storing a current size of a window within which the page is displayed, storing positions of scroll boxes in scroll bars in the window and storing font attributes of the displayed page.
2. Canceled.
3. Canceled.
4. Canceled.
5. Canceled.
6. (Previously presented) The method of Claim 1 wherein the step of storing the section of the page includes storing X-Y coordinates of the window and the scroll boxes.

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7. (Previously presented) A computer program product on a computer readable medium for bookmarking a section of a Web page comprising:

code means for storing a network address of the page;
and

code means for storing the section of the page such that when the network address is used to access and display the page, the section of the page is displayed, the section storing code means including code means for storing a current size of a window within which the page is displayed, code means for storing positions of scroll boxes in scroll bars in the window and code means for storing font attributes of the displayed page.

8. Canceled.

9. Canceled.

10. Canceled.

11. Canceled.

12. (Previously presented) The computer program product of Claim 7 wherein the code means for storing the section of the page includes code means for storing X-Y coordinates of the window and the scroll boxes.

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13. (Previously presented) An apparatus for bookmarking a section of a Web page comprising:

means for storing a network address of the page; and

means for storing the section of the page such that when the network address is used to access and display the page, the section of the page is displayed, the section storing means including means for storing a current size of a window within which the page is displayed, means for storing positions of scroll boxes in scroll bars in the window and means for storing font attributes of the displayed page.

14. Canceled.

15. Canceled.

16. Canceled.

17. Canceled.

18. (Previously presented) The apparatus of Claim 13 wherein the means for storing the section of the page includes means for storing X-Y coordinates of the window and the scroll boxes.

19. (Previously presented) A computer system for bookmarking a section of a Web page comprising:

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at least a memory device for storing data;

at least a processor for processing said data to store a network address of the page and to store the section of the page such that when the network address is used to access and display the page, the section of the page is displayed, the data is further processed to store a current size of a window within which the page is displayed, to store positions of scroll boxes in scroll bars in the window and to store font attributes of the displayed page.

20. Canceled.
21. Canceled.
22. Canceled.
23. Canceled.
24. (Previously presented) The computer system of Claim 19 wherein the section of the page is stored by further storing X-Y coordinates of the window and the scroll boxes.

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